



ITW

PTO/SB/21 (08-08)
Approved for use through 09/30/2008. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	10/561,800
Filing Date	11/13/2006
First Named Inventor	Dieter REIF
Art Unit	4121
Examiner Name	J. Berrios
Attorney Docket Number	50187

ENCLOSURES (Check all that apply)

- ☐ Fee Transmittal Form
- ☐ Fee Attached
- ☒ Amendment/Reply
 - ☐ After Final
 - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/Incomplete Application
 - ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53

- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation
- ☐ Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
- ☐ Landscape Table on CD

- ☐ After Allowance Communication to TC
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☐ Other Enclosure(s) (please identify below):

Remarks

The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 18-2220. A duplicate copy of this sheet is attached.

- ☒ [X] Any additional excess claim fees under 37 C.F.R. § 1.16.
- ☒ [X] Any additional patent application processing fees under 37 C.F.R. § 1.17.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Roylance, Abrams, Berdo & Goodman, L.L.P. (Customer No. 01609)		
Signature			
Printed name	Garrett V. Davis		
Date	01/21/2009	Reg. No.	32,023

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name		Date	

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT

50187

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	
Dieter REIF et al.	:	Art Unit: 4121
Serial No.: 10/561,800	:	Examiner: J. Berrios
Filed: November 13, 2006	:	
For: BONE FORMATION AGENT AND	:	
METHOD OF PRODUCTION	:	

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In the Action, the claims are restricted to Group I, including claims 1-20 directed to the bone formation agent, and Group II, including claims 21-32 directed to a method of producing the bone formation agent.

In response, Applicants provisionally elect the Group I claims, including claims 1-20 directed to the bone formation agent. This election is made with traverse.

The Examiner cites PCT Rule 13.1 which states that “an application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept”. Applicants respectfully submit that the claims of Group I and Group II are in conformity with PCT Rule 13.1. The claims of Group I are directed to a porous bone formation agent which is obtained from defined substances and have specifically defined properties such as, for example, the particle size and porosity. The Group I claims also define the pore in defined size distributions and defined compounds with a specifically

defined geometric shape. The solution to obtain this technical feature of the invention is by the method of the Group II claims, including claims 21-32. Accordingly, Applicants respectfully submit that the two groups of claims belong to one inventive concept and should be examined in this application.

The Examiner also refers to PCT Rule 13.2 which states that “where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art”.

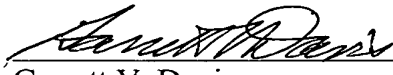
The prior art defines porous materials for bone formation. However, in the present invention, the nature of the pores, the size of the pores, the distribution of the pore size, the porosity and percent, the character of the pores which interconnect, the characteristics of the pores (morphology, appearance), the particle size of the materials from which the porous materials are made, as well as the polygonal shape of the material for bone formation clearly differs in their entirety from the state of the art. The technology for obtaining these characteristic materials of the present invention is novel and does not differ from the materials in the Group I claims, including claims 1-20. Therefore, a technical relationship is clearly provided, since the claimed bone formation agent cannot be obtained without the solution to the technical problem underlying the present invention.

On page 3 of the Action, the Examiner indicates that the Group I claims do not share a special technical feature with the instant claims of Group II. The Examiner also refers to claims 11-13 and 19 of the Group I claims. The basis for this position is not clear since claims 11-13 and 19 depend from claim 1. Moreover, the Group I and Group II claims

include the same special technical feature. For example, independent claim 1 and independent claim 21 refer to the two discrete pore size distributions and the sintered particles of calcium phosphate. Claim 27, which depends from claim 23, recites the particle size of the starting material having a particle size smaller than 63 μm with a particle size distribution in the range of 5 to 20 μm . Thus, the Group I and Group II claims recite the same technical feature of the invention.

In view of the above comments, Applicants respectfully submit that the claims exhibit a single general inventive concept and exhibit a unity of invention under the PCT rules. Accordingly, Applicants request that the restriction be withdrawn.

Respectfully submitted,


Garrett V. Davis
Reg. No. 32,023

Roylance, Abrams, Berdo & Goodman, L.L.P.
1300 19th Street, N.W., Suite 600
Washington, DC 20036
(202)659-9076

Dated: Jan 21, 2009